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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,551	10/18/2001	Hiroataka Noro	740670-269	5064
31780	7590	06/30/2006	EXAMINER	
ERIC ROBINSON PMB 955 21010 SOUTHBANK ST. POTOMAC FALLS, VA 20165			TANG, KAREN C	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,551

Applicant(s)

NORO, HIROTAKA

Examiner

Karen C. Tang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/21/06 has been entered.
- Claims 7-9 are presented for further examination.

Claim Rejections - 35 USC § 101

Claims 7-9 rejected under 35 U.S.C. 101, non-statutory subject matter, process is not useful because its illegal. The amended claimed 7, 8, and 9 indicates that: means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright; means contained in the control apparatus adapted to operate to initialize a title area in a memory contained in the control apparatus when the information of claiming the copyright is judged to be included and to extract title information from the acquired disk information of the target reproduction and store the extracted title information in the title area in the memory when the information of claiming the copyright is judged not to be included; the claimed invention lacks patentable utility. Regarding with Applicant's amendment to the claim languages, the copying of musical data from fixed tangible medium, Examiner reminds applicant that any musical data (either published or non published) is protected by the Federal Copyright Act (17 USC 101, et, al) and as such, is illegal to copy without permission, regarding of notice.

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For the examination purpose, the part of amended claims will not be examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda (US 6,594,740) in view of Applicant Admitted Prior Art (AAPA - Background Information).

1. Referring to Claim 7, Fukuda discloses audio system having a recording/reproducing apparatus for recording on a record disk music data reproduced from a reproduction disk and a control apparatus for controlling the recording/reproducing apparatus, the control apparatus being adapted to communicate with an external information management server via a predetermined interface, the audio system comprising:

means contained in the recording/reproducing apparatus for transferring identification information for identifying a target reproduction disk to the control apparatus (Col 2, Lines 45-60, Col 7, Lines 20-35, Col 17, Col 19, Lines 15-67);

means contained in the control apparatus for communicating with the external information management server to acquire disk information of the target reproduction disk from the external information management server on the basis of the identification information (refer to Col 10, Lines 25-35, Col 20, Lines 15-67);

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and means contained in the recording/reproducing apparatus for registering in the record disk the extracted title information (refer to Col 17, Lines 1-20 and Col 19, and 20).

means contained in the control apparatus, the means operating to extract title information from the acquired disk information of the target reproduction disk (refer to Col 18, Lines 1-10);

and means contained in the recording/reproducing apparatus for registering in the record disk the extracted title information (refer to Col 17, Lines 1-20, Col 19, Col 20).

Fukuda does not expressly disclose transferring the extracted title information from the memory to the recording/reproducing apparatus in response to the completion of the recording of one piece of music.

AAPA discloses transferring the extracted title information from the memory to the recording/reproducing apparatus in response to the completion of the recording of one piece of music (pg 2, Lines 15-25, Pg 3, and pg 4, Lines 1-10, the claim language does expressly indicate the correspondence between the title of the music and the piece of the music that are being recorded/reproduced, therefore, for example, once the system senses that a music piece A is completely recorded/reproduced (completion of the recording of one piece of music), then the system starts transferring the title of music piece B (transferring the extracted title information), once that is being completed, the system starts to record/reproduce music piece B.).

Fukuda did not expressly indicate means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright.

AAPA disclosed means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright (refer to Page 2, Lines 25-30 and Page 3, Lines 1-15).

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the AAPA and Fukuda. Both Fukuda and AAPA inventions are about recording music pieces with their relevant information, and Fukuda discloses methods of reproducing/recording music including the title and related information (Col 21, Lines 1-10).

The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

2. Referring to Claim 8, Fukuda discloses an audio system having a recording/reproducing apparatus for recording on a record disk music data reproduced from a reproduction disk and a control apparatus for controlling the recording/reproducing apparatus, the control apparatus being adapted to communicate with an external information management server via a predetermined interface, the audio system comprising:
means contained in the recording/reproducing apparatus for transferring identification information for identifying a target reproduction disk to the control apparatus (Col 2, Lines 45-60, Col 7, Lines 20-35, Col 17, Col 19, Lines 15-67 and Col 10, lines 20-59 and Col 20, Lines 30-55);

means contained in the control apparatus for communicating with the external information management server to acquire disk information of the target reproduction disk from the external information management server on the basis of the identification information (Col 10, Lines 25-35, and Col 20, Lines 15-67);

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means contained in the control apparatus, the means operating to extract title information from the acquired disk information of the target reproduction disk (refer to Col 18, Lines 1-10), and means contained in the recording/reproducing apparatus for registering in the record disk the extracted title information (refer to Col 17, Lines 1-20, Col 19, Col 20).

Fukuda does not expressly disclose in accordance with information in the title area in the memory, for editing the extracted title information to instruct the recording/reproducing apparatus to record the music data after completing the editing, and to transfer the edited title information from the memory to the recording/reproducing apparatus in response to the completion of the recording of the music data in the recording/reproducing apparatus;

AAPA discloses in accordance with information in the title area in the memory, for editing the extracted title information to instruct the and to transfer the edited title information from the memory in response to the completion of the recording of the music data in the recording/reproducing apparatus (pg 2, Lines 15-25, Pg 3, and pg 4, Lines 1-10, it is being interpreted that extracted title is being transferred in response to the one piece of music is completely recorded.);

Fukuda did not expressly indicate means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright.

AAPA disclosed means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright (refer to Page 2, Lines 25-30 and Page 3, Lines 1-15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the AAPA and Fukuda. Both Fukuda and AAPA inventions are about recording music

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pieces with their relevant information, and Fukuda discloses methods of reproducing/recording music including the title and related information (Col 21, Lines 1-10).

The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

3. Referring to Claim 9, Fukuda discloses an audio system having a recording/reproducing apparatus for recording on a record disk music data reproduced from a reproduction disk and a control apparatus for controlling the recording/reproducing apparatus, the control apparatus being adapted to communicate with an external information management server via a predetermined interface, the audio system comprising:

- means contained in the recording/reproducing apparatus for transferring both identification information for identifying a target reproduction disk and text data acquired from the target reproduction disk to the control apparatus (Col 2, Lines 45-60, Col 7, Lines 20-35, Col 17, Col 19, Lines 15-67 and Col 10, lines 20-59 and Col 20, Lines 30-55);
- means contained in the control apparatus for communicating with the external information management server to acquire disk information of the targets reproduction disk from the external information management server on the basis of the identification information (refer to Col 17, Lines 1-20, Col 19, Col 20);
- means contained in the control apparatus for extracting title information from the acquired disk information of the target reproduction disk and for transferring the extracted title information to the recording/reproducing apparatus (refer to Col 17, Lines 1-20 and Col 19, and 20); and means

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contained in the recording/reproducing apparatus for registering in the record disk the extracted title information (refer to Col 17, Lines 1-20 and Col 19, and 20).

Fukuda does not expressly disclose contained in the control apparatus for editing the text data and does not expressly disclose transferring the extracted title information from the memory to the recording/reproducing apparatus in response to the completion of the recording of one piece of music.

AAPA discloses means contained in the control apparatus for editing the text data and transferring the extracted title information from the memory to the recording/reproducing apparatus in response to the completion of the recording of one piece of music (pg 2, Lines 15-25, Pg 3, and pg 4, Lines 1-10, it is being interpreted that extracted title is being transferred in response to the one piece of music is completely recorded.);

Fukuda did not expressly indicate means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright.

AAPA disclosed means contained in the control apparatus for judging whether the acquired disk information includes information of claiming a copyright (refer to Page 2, Lines 25-30 and Page 3, Lines 1-15).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the AAPA and Fukuda. Both Fukuda and AAPA inventions are about recording music pieces with their relevant information, and Fukuda discloses methods of reproducing/recording music including the title and related information (Col 21, Lines 1-10).

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The suggestion/motivation for doing so would have been that by implement via network, it can provides convenience accessibility for the users around the world to download/reproducing/recording piece of music of their choices.

Response to Arguments

Applicant's arguments with respect to claims 7-9 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571)272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER